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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/586,131	06/02/2000	Marc Delcourt	1184-00	6329

22469 7590 09/29/2004

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EXAMINER

TRAN, MY CHAU T

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/586,131	DELCOURT, MARC	
	<b>Examiner</b>	<b>Art Unit</b>	
	MY-CHAU T TRAN	1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-20 and 23 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Status of Claims*

1. Applicant's amendment filed 5/20/2004 is acknowledged and entered. Claims 1, 16, and 18-19 have been amended.
2. Claims 1, and 16 were amended and Claim 23 was added by the amendment filed on 10/20/2003.
3. Claims 11, and 21-22 were canceled by the amendment filed on 11/25/2002.
4. Claims 1-10, 12-20, and 23 are pending.

### *Election/Restrictions*

5. Claims 20 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to ***nonelected invention***, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 4/12/2001.
6. Claim 23 is withdrawn from consideration as being directed to a non-elected invention pursuant to 37 CFR 1.142(b) and MPEP § 821.03 since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. See Office Action mailed 2/19/2004.

Art Unit: 1639

7. This application contains claims 20 and 23 are drawn to an invention nonelected **without** traverse in the reply filed on 4/12/2001 and Office Action mailed 2/19/2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

***Priority***

8. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. Thus the denial of the foreign priority is withdrawn.

9. This application is a continuation of PCT/FR98/02629 filed on 12/4/1998, which claims priority to a foreign application France 97/15319 filed 12/04/1997.

10. Claims 1-10, and 12-19 are treated on the merit in this Office Action.

***Withdrawn Rejections***

11. The rejections of claims 1-10, and 12-19 under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention have been withdrawn in light of applicant's amendments of claims 1, 16, and 18-19.

*New Rejections – Necessitated by Amendment*

*Claim Rejections - 35 USC § 112*

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claims 1-10, and 12-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is made in view of the amendments to Claims 1, 16, and 18 that overcome the previous rejections under 35 U.S.C. 112, second paragraph.

a. The term “substantially” in claims 1, 16, and 18 is a relative term which renders the claim indefinite. The term “substantially” is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear as to the degree of ‘similarity’ that the second initial library would have to be to be considered “substantially” the same as the first initial library as claimed in step f) of claim 1, step h) of claim 16, and step e) of claim 18.

b. The screening step (e) of claim 1 with regard to the subjecting step (d) of claim 1 is incomplete and thus is indefinite. Step (d) of claim 1 recite the step of “subjecting the first initial library to a plurality of restriction enzymes individually to produce a group of monodigested libraries”, and step (e) of claim 1 recite the step of “screening the group of monodigested libraries for the known characteristic to detect the presence of the target fragments”; however the screening step is incomplete since it is unclear as to the manner in which the monodigested libraries are being screened. That is the subjecting step can

Art Unit: 1639

be interpreted as either each individual member of the first initial library is being subjected to each individual restriction enzyme or each 'portion' of the first initial library is being subjected to each individual restriction enzyme and thus produce a group of monodigested libraries. The screening step would be different for the resulting 'products' of the subjecting step, and thus the screening step (e) of claim 1 with regard to the subjecting step (d) of claim 1 is indefinite.

c. Claims 1, 16, and 18 are incomplete and thus are indefinite because it is unclear as the relationship of the first initial library and the second initial library with regard to the claimed method of isolating a target nucleic acid fragment having known characteristic.

d. Claim 19 is incomplete and thus is indefinite because the resulting 'product' would be one monodigested library not 'a series of monodigested libraries' as claimed in the process of claim 19. Claim 19 recite a method for producing a series of monodigested libraries from a group of fragments. That is, the claimed method is incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

***Allowable Subject Matter***

14. Claims 1-10, and 12-19 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

*Conclusion*

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MY-CHAU T TRAN whose telephone number is 571-272-0810. The examiner can normally be reached on Mon.: 8:00-2:30; Tues.-Thurs.: 7:30-5:00; Fri.: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANDREW WANG can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1639

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mct

September 22, 2004



PADMASHRI PONNALURI  
PRIMARY EXAMINER